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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,494	06/30/2006	Christoph Matzig	MATZ3004/JEK	2909
23364 7590 04/27/2010 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
HAGEMAN, MARK				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
04/27/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/550,494

**Applicant(s)**

MATZIG, CHRISTOPH

**Examiner**

Mark Hageman

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Specification***

1. The amendment filed 12-24-2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amended language of paragraph 14 is new matter. In particular "during the deposit or money receiving portion of the ongoing money deposit transaction." This implies some limitation of the different portions of the transaction which was not present in the originally filed disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both claims 1 and 8 include the language objected to above. Examiner contends that this limitations "during a deposit or money

receiving portion of the deposit transaction" is not supported by the specification as originally filed. Additionally examiner maintains that the added language does not provide adequate transactional boundaries and thus the prior art rejections are reiterated below

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-6 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,596,924 to Watanabe. Watanabe discloses inserting the bank notes to be deposited into an input pocket of the apparatus (c7 lines 32+) during a deposit or money receiving portion of the deposit transaction, checking the inserted bank notes by a checking device of the apparatus at least as to the authenticity, and the state of the bank notes and determining fitness for circulation of said banknotes as a result of the checking (c7 lines 51+ and c11 lines 40+), transporting at least parts of the bank notes which were recognized as not fit for circulation by the checking device into a storage pocket of the apparatus not accessible by the operator during the deposit or money receiving portion of the deposit transaction the ongoing money deposit transaction (c11 lines 53+), transporting at least parts of the bank notes which were recognized as fit for

circulation by the checking device into a storage pocket of the apparatus freely accessible by the operator during the ongoing money deposit transaction (c12 lines 35+), subsequently transporting the bank notes located in the not accessible storage pocket into a bank note cassette not accessible by the operator (c10 lines 15+) and crediting the account of the operator for the amount of money deposited by the operator and retained by the apparatus (c8 lines 65+).

Re claims 2-5 and 9-11 see 4, 9, 12, 13 and c10 lines 43+ and figure 1.  
Examiner further notes that initially all notes deemed authentic are to be retained.

Re claim 6 and 12 criteria used by the checking device for checking the bank notes as to their fitness state are changeable. Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the device as cited above is certainly capable of having the criteria be changeable or relate to one or more of an amount, a number, a currency and a denomination of the bank notes. In fact, the device allows the user to input specific criteria (c10 lines 43+).

Re claim 8 an input pocket accessible during the ongoing money deposit transaction, an input pocket (7) accessible during the ongoing money deposit transaction, for inserting bank notes to be deposited, a checking device (30) arranged to

check bank notes inserted into the input pocket at least as to the authenticity and state of the bank notes and to determine fitness for circulation of said banknotes, a storage pocket not accessible during the ongoing money deposit transaction, a storage pocket (8) freely accessible during the ongoing money deposit transaction, a not accessible bank note cassette, and a transport system (32, figure 2) arranged to transport the bank notes from the input pocket to the checking device, from the checking device to the freely accessible storage pocket, and to the not accessible storage pocket during the ongoing money deposit transaction, and from the not accessible storage pocket into the bank note cassette following the money deposit transaction, and a control unit arranged to actuate the transport system in such a way that bank notes not fit for circulation at least partially are transported into the not accessible storage pocket, and bank notes fit for circulation at least partially are transported into the freely accessible storage pocket during the ongoing money deposit transaction (c11 lines 53+ and c12 lines 35+).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over by WO 02/50784 to Matzig in view of Watanabe. References below are to portions of US 2004/0064413 which applicant has discussed at the equivalent of WO 02/50784. Matzig

(Fig.) teaches an apparatus for executing a money deposit transaction, namely depositing bank notes comprising:

- an input pocket (3) accessible during the ongoing money deposit transaction, for inserting bank notes to be deposited,

- a checking device (10) arranged to check bank notes inserted into the input pocket at least as to the authenticity and state of the bank notes and to determine fitness for circulation of said banknotes resulting therefrom (para. 29, 37-39),

- a storage pocket (14) not accessible during the ongoing money deposit transaction,

- a storage pocket (4, 5) freely accessible during the ongoing money deposit transaction,

- a not accessible bank note cassette (15), and

- a transport system (9) arranged to transport notes from the input pocket to the checking device, from the checking device to the freely accessible storage pocket, the not accessible storage pocket, and from the not accessible storage pocket into the bank note cassette (para. 29, 37-39 and 42 teaching the transport of not recognized bank notes, under the control of the control unit, into a further, freely accessible storage pocket and retaining notes beyond those needed for change);

- and a control unit (17), arranged to actuate the transport system in such a way bank notes fit for circulation at least partially are transported into the freely accessible storage pocket (para. 29-32 and para 42);

Matzig does not disclose relative to claims 1 and 8 respectively transporting at least parts of the bank notes which were recognized as not fit for circulation by the checking device into a storage pocket of the apparatus not accessible by the operator during the ongoing money deposit transaction and the control system controlling the transport system to carry out such an operation. Watanabe discloses transporting at least parts of the bank notes which were recognized as not fit for circulation by the checking device into a storage pocket of the apparatus not accessible by the operator during the ongoing money deposit transaction and the control system controlling the transport system to carry out such an operation (c11 lines 23+) in order to accept all authentic notes that can be determined as such while preventing authentic but unfit bills from continued circulation (c11 lines 28+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Matzig to include the retention of unfit bills, as taught by Watanabe, in order to accept all authentic notes that can be determined as such while preventing authentic but unfit bills from continued circulation.

Matzig further discloses a display and input unit (6), for the input of criteria for the transportation of the bank notes either or both fit for circulation and not fit for circulation into either or both the freely accessible storage pocket and the not accessible storage pocket (para. 31 et seq. and para. 13 teaching that criteria can be supplied remotely via data transmission thus it is implicit that unit is connected to cash desk). Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus



must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the device as cited above is certainly capable of having the criteria be changeable or relate to one or more of an amount, a number, a currency and a denomination of the bank notes. In fact, the device allows the user to input specific criteria (para. 34 et seq.). The method claims are anticipated in the normal operation of the device cited above.

### ***Response to Arguments***

4. Applicant's arguments filed 12-24-2009 have been fully considered but they are not persuasive. Applicant stated, "Watanabe does not check fitness of bank notes during the deposit portion of a money deposit transaction." Examiner maintains that the claim does not define the "the deposit portion" in way that precludes the examiner's interpretation. Examiner maintains that the claimed transaction is open ended as it is not clear when the transaction ends and thus Watanabe anticipates the claim. When is the "the deposit portion" done? Examiner notes that during the deposit portion notes are also returned to the user (as set forth in the preamble to claim 8).

5. Regarding the rejection under 103 applicant focuses on the disclosure of Watanabe and that such a combination would be a drastic re-design of Matzig. Examiner disagrees and maintains that Matzig discloses checking notes for fitness upon being deposited in the machine and Watanabe discloses a method by which such notes are stored to be removed from circulation (regardless of when they are checked). Examiner maintains that the application of the storage techniques from Watanabe to the

Matzig apparatus and method is within the level ordinary skill and would have been obvious to one of ordinary skill in the art. Further although not relied upon in the rejection examiner notes that there are only two times in which the fitness of the bill can be checked, during deposit and/or withdrawal. Watanabe discusses checking them on withdrawal and Matzig discusses checking them on deposit. Examiner contends that the limited number of possibilities along with the fact that both are taught in the prior art suggest the obviousness of such a configuration.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saul Rodriguez can be reached on (571) -272-7097. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Q. Nguyen/  
Supervisory Patent Examiner, Art Unit 3654

MCH